

REMARKS

In response to the Office Action dated February 14, 2006, claims 1, 9, 17, 18, and 22 have been amended. Claims 1-22 are in the case. Reexamination and reconsideration of the application, as amended, are requested.

The Office Action rejected claims 1-22 under 35 U.S.C. § 102(e) as being anticipated by Tafoya et al. (U.S. Patent No. 6,829,607).

The Applicants respectfully traverse this rejection based on the amendments to the claims and the arguments below.

The Applicants' invention now includes displaying a list of most recently used email addresses and/or most frequently used email addresses in response to user input from a **mouse** input device configured for clicking on a software button and not in response to a user typing characters into an addressing field.

In contrast, although Tafoya et al. disclose a system that "...automatically provides dynamically generated completion information for facilitating user input of email addresses or contact information," Tafoya et al. is missing the Applicants' newly claimed selectively displaying a list of most recently used email addresses in response to user input from a **mouse** input device configured for clicking on a software button and not in response to a user typing characters into an addressing field. Namely, paragraph [0042] of the Applicants' U.S. Patent publication states that the "...list is displayed in a drop-down menu or other type of list or menu that may be selectively activated via user input, such as via the **clicking of a mouse** on a software button."

Specifically, the Tafoya et al. reference only discloses displaying a list of email addresses when the user begins typing an email address, in other words, a list of email addresses is **only** presented after the user actually starts to type something. Namely, Tafoya et al. explicitly states that "...as a user types characters into an addressing field 612, a pop-up menu 610 appears directly below the cursor 614, as shown in FIG. 6" *[emphasis added]* (see col. 13, lines 65-67 and col. 14, lines 46-63). Consequently, the objective in Tafoya et al. is automatic completion of the email address **after** the user starts to type (i.e., "type-ahead"). Tafoya et al. clearly states that it "...provides **dynamically generated completion information** for facilitating user input of email addresses or contact information... **As a user begins to input an email address or contact**, the present invention can either **automatically complete** the entry using a

using a most probable result from the resolution list, or can display a list of likely matches from which the user may select the desired email address or contact.”

[*emphasis added*] (see Abstract of Tafoya et al.).

Hence, since the cited reference does not disclose all of the elements of the claimed invention, the reference cannot anticipate the claims. As such, the Applicants respectfully submit that the rejection under 35 U.S.C. 102 should be withdrawn.

Further, the Tafoya et al. reference teaches away from the Applicants' claimed invention. Specifically, as discussed above, Tafoya et al. discloses that “...**as a user types characters into an addressing field...**” the list of email addresses appear, in contrast to the Applicants' claimed invention, which selectively displays a list of most recently used email addresses in response to user input from a **mouse** input device configured for clicking on a software button and not in response to a user typing characters into an addressing field. Thus, since Tafoya et al. requires a **user to type characters into an addressing file**, the device in Tafoya et al. would be inoperable or non-functional if an attempt was made to display the list of most recently used email addresses in response to user input from a **mouse and not in response to a user typing characters into an addressing field**, which is a teaching away from the Applicants' claimed invention.

Hence, any attempts in Tafoya et al. to display the list of addresses without a user typing characters into an addressing field, like the Applicant's claimed invention, would render the main functions of Tafoya et al. inoperable. As such, this “teaching away” prevents the Tafoya et al. reference from being used by the Examiner. ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

Therefore, since the above argued elements of the Applicants' claimed invention are not disclosed by Tafoya et al. and because Tafoya et al. teaches away from the Applicants' invention, Tafoya et al. cannot be used as a reference to reject the claims. As such, the Applicants submit that the rejection should be withdrawn. *MPEP 2143*.

With regard to the rejection of the dependent claims, because they depend from the above-argued respective independent claims, and they contain additional limitations that are patentably distinguishable over the cited references, these claims are also considered to be patentable (*MPEP* § 2143.03).

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Thus, it is respectfully requested that all of the claims be allowed based on the amendments and arguments. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the Applicant kindly requests the Examiner to telephone the Applicant's attorney at (818) 885-1575.

Please note that all mail correspondence should continue to be directed to

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